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To: Commissioner for Patents for Examiner Michael Bekerman Group Art Unit 3622	Facsimile No.: 571/273-8300
From: Stephanie Fay Legal Assistant to Francis Lamnes	No. of Pages Including Cover Sheet: 7
Message: Enclosed herewith: <ul style="list-style-type: none"> • Transmittal of Reply Brief, and • Reply Brief. 	
Re: Application No. 09/766,357 Attorney Docket No: RSW920000110US1	
Date: Wednesday, September 13, 2006	
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Moore

Serial No.: 09/766,357

Filed: January 19, 2001

For: Automated and Optimized Mass
Customization of Direct Marketing
Materials

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Group Art Unit: 3622

Examiner: Bekerman, Michael

Attorney Docket No.: RSW920000110US1

37945

PATENT TRADEMARK OFFICE
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<p><u>Certificate of Transmission Under 37 C.F.R. § 1.8(a)</u> I hereby certify this correspondence is being transmitted via facsimile to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, facsimile number (571) 273-8300 on September 13, 2006. By: <u>Stephanie Fay</u> Stephanie Fay</p>

TRANSMITTAL OF REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:
ENCLOSED HEREWITH:

- Reply Brief (37 C.F.R. 41.41).

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0457.

Respectfully submitted,

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Docket No. RSW920000110US1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Group Art Unit: 3622

Examiner: Bekerman, Michael

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on September 13, 2006.

By:

Stephanie Fay
Stephanie Fay

REPLY BRIEF (37 C.F.R. 41.41)

This Reply Brief is submitted in response to the Examiner's Answer mailed on July 27, 2006.

No fees are believed to be required to file a Reply Brief. If any fees are required for filing this
Reply Brief, those fees are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

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RESPONSE TO EXAMINER'S REMARKS**A. GROUND OF REJECTION (Claims 1, 8-10, 17-19, 26, and 27)**

In response to Appellant's assertion that *Kent* and *Cornuejols*, taken alone or in combination, fail to teach or suggest an optimization model used to customize the layout areas for customers, wherein the optimization model used to combine the layout areas is at least one of a transportation model, a network model, or a generalized network model, the Examiner's Answer states:

The feature of the claimed invention that isn't specified by *Kent* is the particular type of optimization model that may be used. Examiner's argument is that one skilled in the art of optimization (*Kent*) would find it obvious to use any optimization model as taught by *Cornuejols*.

Appellant respectfully submits that one of ordinary skill in the art of customizing direct marketing materials would not find it obvious to use any optimization model as taught by *Cornuejols*. Appellant respectfully submits that the invention is directed to customizing direct marketing materials rather than optimizations as alleged by the Examiner.

As stated in Appellant's Brief, *Cornuejols* is directed to quantitative methods for management sciences and provides for a formal quantitative approach to problem solving. More specifically, the cited sections of *Cornuejols* are directed to network optimization that is a special type of linear programming model (see section 11.1). *Cornuejols* relates a network to consist of points and lines that connect pairs of points (see section 11.2). *Cornuejols* provides examples of a network where his network optimization may be useful in section 11.3. In section 11.3.1, *Cornuejols* refers to a phone network where telecommunications companies spend time and money tracking delays. In section 11.3.3, *Cornuejols* refers to a snow removal problem where the snow must be moved out of a district to a convenient location. Thus, Appellant respectfully submits that, while the terms "transportation model," "network model," and "generalized network model" may appear in the *Cornuejols* reference, *Cornuejols* simply is not directed towards and does not suggest customizing direct marketing materials.

Appellant respectfully submits that one of ordinary skill in the art of customizing direct marketing materials would not look to a class that teaches optimizing telecommunication networks

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and snow removal to teach or suggest customizing layout areas for customers using an optimization model. Appellant respectfully submits that there is no teaching, suggestion, or incentive present to combine the teachings of *Kent* with the teaching of *Cornuejols* in a manner asserted by the Examiner. That is, *Kent* does not teach or suggest an optimization model to customize the layout areas for customers, wherein the optimization model used to customize the layout areas is at least one of a transportation model, a network model, or a generalized network model. *Cornuejols* may teach a transportation model, a network model, and a generalized network model, but this cited reference does not teach or suggest customizing direct marketing materials.

In response to Appellant's assertion that there are no reasons to combine references *Cornuejols* and *Kent* other than those provided in the Appellant's specification, the Examiner's Answer states:

Kent acknowledges the availability of multiple optimization programs with the statement, "In most optimization programs, there are a number of conflict evaluation criteria..." (Kent, Paragraph 0077). Cornuejols teaches a copy of instructional notes used by a professor in a university setting to teach students (those attempting to become skilled in the art) optimization. While Cornuejols specifies the examples as network optimization, Cornuejols teaches the concept and principles of optimization using transportation model, network model, and generalized network model. Anyone skilled in the art of optimization (having studied optimization techniques as taught by Cornuejols) would find it obvious to modify Kent using whichever model they prefer. More importantly, Kent teaches the desirability to use optimization for solving the problem of determining custom content layouts for users.

As discussed in Appellant's Brief and above, the Examiner's reason for combining the references is erroneously based upon *Cornuejols* teaching the concept and principles of optimization using transportation model, network model, and generalized network model and that anyone skilled in the art of optimization (having studied optimization techniques as taught by *Cornuejols*) would find it obvious to modify *Kent* using whichever model they prefer. Appellant respectfully submits that one of ordinary skill in the art of customizing direct market materials would not have studied an Industrial Administration course that teaches optimizing telecommunication networks and snow removal.

In response to Appellant's assertion *Cornuejols* is directed to mathematical operations and not toward customizing direct marketing materials, the Examiner's Answer states:

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Examiner asserts that the purpose for mathematical operations is to be used in real-world operations. The customizing of direct marketing materials is a real-world operation, and just because Cornuejols does not limit the course note examples to any one real-world operation (including the one taught by the Appellant) does not mean the information taught by Cornuejols does not read on the claimed invention.

Appellant respectfully submits that the *Cornuejols* reference does have real-world use in industrial application such as optimizing telecommunication networks and snow removal. However, Appellant respectfully submits that of ordinary skill in the art of customizing direct market materials would not have studied an Industrial Administration course that teaches optimizing telecommunication networks and snow removal.

In response to Appellant's assertion if one were somehow motivated to combine *Kent* and *Cornuejols*, and it were somehow possible to combine the two systems, the result would not be the invention, the Examiner's Answer states:

From the previous statement, Appellant appears to admit that there is a possibility of combining the 2 references. Examiner, however, feels that Appellant has failed to provide clear and convincing reasoning that the combination of Kent and Cornuejols would not create the same invention. Examiner feels that the combination of Kent and Cornuejols would indeed result in the claimed invention.


Appellant respectfully submits that the Examiner appended only a portion of Appellant's argument. Appellant stated: "To the contrary, even if one were somehow motivated to combine *Kent* and *Cornuejols*, and it were somehow possible to combine the two systems, the result would not be the invention, as recited in claims 1, 10, and 19." This statement clearly does not admit that they can be combined. Instead this section says that for arguments sake that even if you could combine them the combination would not reach the claims on appeal. This is a hypothetical statement, not an actual admission as the Examiner mistakenly believes. Thus, Appellant made no admission that the two references should be combined to reach the invention as recited in claims 1, 10, and 19.

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CONCLUSION

In view of the above, Appellants respectfully submits that claims 1-4, 8-13, 17-22, 26, and 27 are allowable over the cited prior art and that the application is in condition for allowance. Accordingly, Appellant respectfully requests the Board of Patent Appeals and Interferences to not sustain the rejections set forth in the Final Office Action.


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